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EXAMINER

BRIER, JEFFERY A

ART UNIT PAPER NUMBER

2672

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,622

Applicant(s)

BARNES ET AL.

Examiner

Jeffery A Brier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23-44, 48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 23-44, 48 and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/15/2004 and refaxed on 12/16/2004 has been entered.

Response to Amendment

2. The after final amendment filed on 10/15/2004 and refaxed on 12/16/2004 has been entered.

Response to Arguments

3. Applicant's arguments filed 10/15/2004 have been fully considered but they are not persuasive.

The arguments concerning the article describing the Rocky Mountain Monument & Vault's monument design software described in the article Funeral Home Online-- Funeral Home Goes High Tech from the Utah Prime Time July 2000 are not fully persuasive because the article does teach in paragraph 17:

Using computer technology, and good design software, you can put just about anything on the stone.

Therefore the article teaches to one of ordinary skill in the funeral planning art that more than just an engraving may be placed onto a headstone. People do attach objects to headstones. People attach flower holders to headstones. People attach veteran's bronze plaques to headstones. Several headstones dating at least from the mid 1990s with veteran's bronze plaques physically attached to the headstone can be viewed in the Cumberland Ohio cemetery. Thus, the article teaches or at least suggests selecting physical objects capable of being permanently fastened to the headstone. Therefore this article teaches or at least suggests compositing the image of the selected correlated item that is capable of being permanently fastened to the funeral item onto the base image in order for the people to see an image of the finished product.

Additionally the Barrot et al. publication (U.S. Patent Application Publication No. 2002/00464046) teaches selecting funeral items that are capable of being permanently fastened onto a base funeral item, see figures 4d, 4e, and 5a for examples of caskets and headstones with selected items that are capable of being permanently fastened onto the casket or headstone.

The arguments concerning the 103 rejection based upon Barrot and the Rocky Mountain Monument article are not persuasive because the article provides to one of ordinary skill in the art motivation to include a compositing process in Barrot. The article teaches the desirability of having a compositing process which allows the user to submit

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their own image(s) or ideas to be superimposed upon the base headstone image and to view at the computer the result of the compositing. By being able to composite at the funeral home's computer, the funeral planning will better help the users during the funeral planning session. Also as stated in the article this type of visual feedback helps in the healing process. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barrot so the image of the selected item for inclusion with the funeral item will be composited onto the image of the funeral item so the user will be able to view the image of the customized funeral item on a display or printout during the funeral planning because the article in paragraph 15 describes giving the customers a better way of viewing the items, in paragraph 16 describes giving the user a laser copy of what the headstone will look like and in paragraph 21 describes how this type of personalization helps in the healing process.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 48-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are program product claims however they do not properly claim a program product storing a program for causing a computer to perform the claimed

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steps. In these claims applicant in essence is claiming functional data stored on computer readable medium. According to MPEP 2106 (emphasis added in bold):

1. Nonstatutory Subject Matter

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." **In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component.** (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance.

These claims do not claim the steps cause a computer to form a composite image.

These claims do not claim what is actually in the program product and does not claim what apparatus the program controls. The claim covers written instructions directing a person to form the composite image. The claim does not claim how a program product

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performs the claimed steps. Computer readable mediums store programs which cause a processor (or processors in a multiprocessor system) to perform steps. Therefore the preamble of these claims need to be amended to conform to current US patent practice.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 48 and 49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 48 and 49:

These claims are program product claims however they do not properly claim a program product storing a program for causing a computer to perform the claimed steps. These claims are unstatutory for the same reasons given above in the 35 USC 112 second paragraph rejection. These claims do not employ the program product as a computer component. These claims do not impart functionality to a machine. The program product needs to be a computer readable medium. Also the computer readable medium needs to be a part of the machine to impart functionality to the machine. Otherwise they are claiming descriptive material per se.

8. Claims 1-21, 23-44, 48 and 49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This application is

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directed to a useful, concrete, and tangible result, however, these claims are not.

These claims are directed to manipulating abstract ideas. State Street Bank & Trust

Co. v. Signature Financial Group Inc. (CA FC) 47 USPQ2d 1596, 1603 (7/23/1998).

AT&T Corp. v. Excel Communications Inc. (CA FC) 50 USPQ2d 1447. On page 1603

first paragraph the CAFC wrote in State Street:

Under Benson , this may have been a sufficient indicium of nonstatutory subject matter. However, after Diehr and Alappat , the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter, unless, of course, its operation does not produce a "useful, concrete and tangible result." Alappat , 33 F.3d at 1544, 31 USPQ2d at 1557. 7

On page 1603 paragraph labeled [4] the CAFC wrote:

[4] The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter-- but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. See In re Warmerdam , 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994).

Claim 1 claims superimposing an overlay image over the base image to form a composite image but it does not display the image to the user. Therefore the composite image is an abstract entity that is not tangible and concrete.

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Claims 23 and 48 claim to display an base image and to superimpose an overlay image over the base image to form a composite image but it does not display the superimposed image to the user. Therefore the composite image is an abstract entity that is not tangible and concrete.

Since State Street in paragraph [4] stated the practical utility of the claim is important then these claims need to claim concrete and tangible result such as displaying the composite image on a display device of the computer to a user.

Supporting excerpts from MPEP 2106 follows.

A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459. Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971). Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.

Federal courts have held that 35 U.S.C. 101 does have certain limits. First, the phrase "anything under the sun that is made by man" is limited by the text of 35 U.S.C. 101, meaning that one may only patent something that is a machine, manufacture, composition of matter or a process. See, e.g., *Alappat*, 33 F.3d at 1542, 31 USPQ2d at 1556; *Warmerdam*, 33 F.3d at 1358, 31 USPQ2d at 1757 (Fed. Cir. 1994). Second, 35 U.S.C. 101 requires that the subject matter sought to be patented be a "useful" invention. Accordingly, a complete definition of the scope of 35 U.S.C. 101, reflecting Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent.

The subject matter courts have found to be outside the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena.

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1. Nonstatutory Subject Matter

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance.

In practical terms, claims define nonstatutory processes if they:

- consist solely of mathematical operations without some claimed practical application (i.e., executing a "mathematical algorithm"); or
- simply manipulate abstract ideas, e.g., a bid (*Schrader*, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (*Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759), without some claimed practical application.

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A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is nonstatutory despite the fact that it might inherently have some usefulness. In *Sarkar*, 588 F.2d at 1335, 200 USPQ at 139, the court explained why this approach must be followed:

No mathematical equation can be used, as a practical matter, without establishing and substituting values for the variables expressed therein. Substitution of values dictated by the formula has thus been viewed as a form of mathematical step. If the steps of gathering and substituting values were alone sufficient, every mathematical equation, formula, or algorithm having any practical use would be per se subject to patenting as a "process" under 101. Consideration of whether the substitution of specific values is enough to convert the disembodied ideas present in the formula into an embodiment of those ideas, or into an application of the formula, is foreclosed by the current state of the law.

For such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *Alappat* 33 F.3d at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("unpatentability of the principle does not defeat patentability of its practical applications") (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T*, 172 F.3d at 1358, 50 USPQ2d at 1452. Likewise, a machine claim is statutory when the machine, as claimed, produces a concrete, tangible and useful result (as in *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601) and/or when a specific machine is being claimed (as in *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557 (in banc)). For example, a computer process that simply calculates a mathematical algorithm that models noise is nonstatutory. However, a claimed process for digitally filtering noise employing the mathematical algorithm is statutory.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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10. Claims 1-3, 5, 7-9, 16, 21, 23, 24, 26, 28-30, 38, 41-43, 48 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by the article describing the Rocky Mountain Monument & Vault's monument design software described in the article Funeral Home Online--Funeral Home Goes High Tech from the Utah Prime Time July 2000 this article was found at <http://www.funeralplan.com/products/fa.html> and at http://www.auroracasket.com/WEB/news_faqs/press_releases/newsoftware.html

This article describes a headstone design software that allow the user to design a headstone by pulling together designs, choosing from thousands of images, selecting fonts for the text, even adding a signature and placing things onto the headstone. See paragraphs 15-21 and note paragraph 17. The article teaches to one of ordinary skill in the funeral planning art that more that just an engraving may be placed on a headstone. People do attach objects to headstones. People attach flower holders to headstones. People attach veteran's bronze plaques to headstones. Several headstones dating at least from the mid 1990s with veteran's bronze plaques physically attached to the headstone can be viewed in the Cumberland Ohio cemetery. Thus, the article teaches selecting physical objects capable of being permanently fastened to the headstone. Therefore this article teaches compositing the image of the selected correlated item that is capable of being permanently fastened to the funeral item onto the base image in order for the people to see an image of the finished product.

A detailed analysis of the claims follows.

Claim 1:

The article describes a computer implemented method (see paragraphs 15-21) for guiding a funeral planning session (*the selection of the headstone's design is one step in the process for guiding a funeral, the whole article is dedicated to describing the software used to plan a funeral session*), comprising:

displaying a base image of a funeral item (*during the headstone design session the user would inherently view many headstones, see paragraph 15, and choose one, the chosen one is the base image*);

superimposing an overlay image (*the text and images selected by the user are the overlay image*) of a correlated item (*the text and images wished by the user to have placed on the headstone are correlated items*) over the base image (see paragraph 16, *a laser copy of the headstone is generated and given to the family which is now a composite image of the base headstone with the computer processed text and images selected by the family*) in response to a user selecting the correlated item in such a manner as to form a composite image (*inherently the system will display the composite image not only on the laser copy but on the computer monitor since paragraph 15 states the virtual showroom is on the computer which means it is presented to the user via a monitor*), wherein the correlated item comprises a physical object capable of being permanently fastened to the funeral item (*The sandblasted image of the user selected correlated item is permanently attached to the headstone. The heavy rubber resist material formed by the user selected object is a physical object that is placed on the*

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headstone for use during the sandblasting process. The article teaches at paragraph 17 to one of ordinary skill in the funeral planning art that more than just an engraving may be placed on a headstone.).

Claim 2:

The article describes the method according to claim 1, further comprising storing image data selected from a group consisting of:

the base image (to create the virtual showroom the base image has to be stored),

the overlay image (In paragraph 18 an image is scanned into the computer, the process of scanning has input image data in the computer which has to be stored for it to be available for use by the computer) and

the composite image (during the process of merging the headstone with the selected text and images provided by the family the computer must store the composited image),

and some combination (this term is interpreted to mean at least one of the base image, overlay image, and composite image), thereof, within a database (According to

yourdictionary.com the term database means: A collection of data arranged for ease and speed of search and retrieval. Also called data bank. The computer used at the

funeral home described in this article would definitely have the virtual showroom

headstone images stored in a database and would definitely store the customer's

information in a database since the design session and printing of the laser copy are at the funeral home and the manufacture of the headstone is at a factory. The funeral

home's computer would have to send the customer's file to the factory which would definitely store the file in a database connected to the computer plotter).

Claim 3:

The article describes the article describes the method according to claim 2, further comprising retrieving the image data from the database (*as described above the base image is stored in a database and it would be retrieved from the database during the virtual headstone showroom tour, during the headstone design session the designed headstone would be stored and then retrieved and transmitted to the factory to have the headstone manufactured, during the printing process of the laser copy to be given to the family the database storing the composite image would accessed to retrieve the composite image*).

Claim 5:

For the reasons given for claims 2 and 3 the database is resident at a local computer at the funeral home.

Claim 7:

A user interface is inherent in the article's teaching because a save option during the design of the headstone is inherent. Also to add or delete headstones from the showroom tour would be inherent.

Claims 8 and 9:

The saved image is an image of the headstone.

Claim 16:

The saved image of the headstones used in the showroom store are photographs.

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Claim 20:

Prompting the user to input during the planning session is inherent in the article's teaching since the user selects a headstone and to do must have some sort of prompt provided by the computer in order to enter the selection.

Claim 21:

Paragraph 19 describes adding text and pictures to the overlay.

Claim 23:

The article describes an apparatus, comprising:

a memory (*the computer performing the software design of the headstone has to have a memory*);

a database resident in the memory (*to perform the virtual showroom tour a database is present in memory*),

the database storing images associated with a plurality of funeral products (*a plurality of headstones is a plurality of funeral products*);

and a program configured to access the database (*to retrieve the image of the headstone the database is accessed*) and retrieve a base image associated with one of the plurality of funeral items (*one of the headstones is one of the funeral items*), display the base image (*during the virtual showroom tour the base image is displayed to the family*), and superimpose an overlay image of a correlated item of the plurality of funeral items over the base image in such a manner as to form a composite image (see *paragraph 16, a laser copy of the headstone is generated and given to the family which is now a composite image of the base headstone with the computer processed text and*

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images selected by the family, inherently the system will display the composite image not only on the laser copy but on the computer monitor since paragraph 15 states the virtual showroom is on the computer which means it is presented to the user via a monitor), wherein the correlated item comprises a physical object capable of being permanently fastened to the funeral item associated with the base image (The sandblasted image of the user selected correlated item is permanently attached to the headstone. The heavy rubber resist material formed by the user selected object is a physical object that is placed on the headstone for use during the sandblasting process. The article teaches at paragraph 17 to one of ordinary skill in the funeral planning art that more than just an engraving may be placed on a headstone.).

Claim 24:

See claim 2.

Claim 26:

See claim 5.

Claim 28:

See claim 7.

Claims 29 and 30:

See claims 8 and 9.

Claim 38:

The headstone, claimed correlated funeral item, is associated with the overlay image by the software when the selected headstone is selected for overlay by the chosen overlay image.

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Claim 41:

See claim 20.

Claim 42:

See claim 21.

Claim 43:

See claim 16.

Claim 48:

The article teaches a program product (*the design software is computer software which requires a program product to operate, thus inherent*), comprising:
a program configured to access a database (*to retrieve the image of the headstone the database is accessed*) storing images associated with a plurality of funeral products (*a plurality of headstones is a plurality of funeral products*) and retrieve a base image associated with one of the plurality of funeral items (*one of the headstones is one of the funeral items*), display the base image (*during the virtual showroom tour the base image is displayed to the family*), and superimpose an overlay image of a correlated item of the plurality of funeral items over the base image in such a manner as to form a composite image wherein the correlated item comprises a physical object capable of being permanently fastened to the funeral item (*See paragraph 16, a laser copy of the headstone is generated and given to the family which is now a composite image of the base headstone with the computer processed text, images, and anything selected by the family, inherently the system will display the composite image not only on the laser copy but on the computer monitor since paragraph 15 states the virtual showroom is on*

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the computer which means it is presented to the user via a monitor. The sandblasted image of the user selected correlated item is permanently attached to the headstone. The heavy rubber resist material formed by the user selected object is a physical object that is placed on the headstone for use during the sandblasting process. The article teaches at paragraph 17 to one of ordinary skill in the funeral planning art that more than just an engraving may be placed on a headstone.); and

a signal bearing medium bearing the program (the computer used to perform the virtual headstone tour, to design the overlay image, and to superimpose the headstone with the overlay image inherently has a program which is inherently stored in a memory which is a signal bearing medium and the memory sends the program to the computer's processor via a signal bearing medium).

Claim 49:

As discussed above the computer used to perform the virtual headstone tour, to design the overlay image, and to superimpose the headstone with the overlay image inherently has a program which is inherently stored in a memory which is a signal bearing medium and the memory sends the program to the computer's processor via a signal bearing medium. The memory is a recordable medium since to have the program in memory the memory was recordable.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-21, 23-44, 48, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrot et al., U.S. Patent Application Publication No. 2002/00464046, and the article describing the Rocky Mountain Monument & Vault's monument design software described in the article Funeral Home Online--Funeral Home Goes High Tech from the Utah Prime Time July 2000.

Barrot describes at page 4 paragraphs 0054-0057 a computer that is either standalone or networked to perform funeral advising and allows the user to select various funeral products for inclusion in the funeral and allows the user to view images of each of the funeral products.

Each of independent claims 1, 23, and 48 claim forming a composite image by superimposing the overlay image over the base image.

Barrot replaces one web page image with another web page image as the user views the funeral products but it does not teach forming a composite image by superimposing the overlay image over the base image.

However, it should be appreciated that figure 5a shows the same viewing room but with different funeral products, however, these web pages are complete files not requiring compositing by superimposing a base image with an overlay image by the

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local computer. However, it should be noted that HTML web pages are formed by HTML code that makes references to image files causing the system to composite the images into the web page seen on the computer screen. However, these commands may or may not overlay one image onto another image.

Therefore, Barrot does teach displaying an image to the user showing the selected products together in a composite image formed before the selection process and stored in a database of images.

The Funeral Home Online--Funeral Home Goes High Tech article describes forming a composite image by overlaying a base image of a headstone with selected images of text, images, pictures, and just about anything, see paragraph 17.

A detailed analysis of independent claims 1, 23, and 48 follows.

Claim 1:

Barrot teaches a computer implemented method for guiding a funeral planning session, comprising:

displaying a base image of a funeral item (*Barrot displays many funeral items so the user may select a funeral item, many of the items such as caskets may be customized which allows the user to select another web page to view the images of a feature of the casket that may be selected for addition to the casket, thus, the initial view of a casket such as shown in figure 4d is a base image*);

superimposing an overlay image of a correlated item over the base image in response to a user selecting the correlated item (*when the user selects an area such as*

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77 in figure 4d the web page showing the image of that item replace the web page shown in figure 4d),

wherein the correlated item comprises a physical object capable of being permanently fastened to the funeral item (*The user selects various physical objects capable of being permanently fastened to the casket*).

Barrot does not teach at lines 5-6 of this claim *superimposing in such a manner as to form a composite image*.

The article describing headstone designing superimposes an overlay image onto the base image of the headstone.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barrot so the image of the selected item for inclusion with the funeral item will be composited onto the image of the funeral item so the user will be able to view the image of the customized funeral item on a display or printout during the funeral planning because the article in paragraph 15 describes giving the customers a better way of viewing the items, in paragraph 16 describes giving the user a laser copy of what the headstone will look like and in paragraph 21 describes how this type of personalization helps in the healing process.

Claim 23:

Barrot teaches an apparatus, comprising:

a memory (*web pages are stored in memory, see paragraphs 0052-0055*);

a database resident in the memory (*the web pages are stored in a database, paragraph 0055 describes a SQL server which is a database server*),

the database storing images associated with a plurality of funeral products (*the web pages store image of funeral products*);

and a program configured to access the database and retrieve a base image associated with one of the plurality of funeral items (*the web browser accesses the database to retrieve images of the funeral items*), display the base image (*the web browser displays the funeral item*), and

superimpose an overlay image of a correlated item of the plurality of funeral items over the base image (*when the user selects an area such as 77 in figure 4d the web page showing the image of that item replace the web page shown in figure 4d*),

wherein the correlated item comprises a physical object capable of being permanently fastened to the funeral item associated with the base image (*The user selects various physical objects capable of being permanently fastened to the casket*).

Barrot does not teach *superimposing in such a manner as to form a composite image*.

The article describing headstone designing superimposes an overlay image onto the base image of the headstone.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barrot so the image of the selected item for inclusion with the funeral item will be composited onto the image of the funeral item so the user will be able to view the image of the customized funeral item on a display or printout during the funeral planning because the article in paragraph 15 describes giving the customers a

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better way of viewing the items, in paragraph 16 describes giving the user a laser copy of what the headstone will look like and in paragraph 21 describes how this type of personalization helps in the healing process.

Claim 48:

This claim is a program product claim version of claim 23 and is rejected for the reasons given for claim 23, additionally, in one embodiment of Barrot's system the web browser on the local computer sends a request from the user to view a page to the network server, the network server, sends the requested web page, the local computer is directed by the sent web page to display the images associated with the web page. The memory storing the program is a signal bearing medium and the network is signal bearing medium during the transmission of the program.

Claim 49:

Barrot teaches the program product of claim 48, wherein the signal bearing medium includes at least one of a recordable medium (*the memory is a recordable medium since to have the program in memory the memory was recordable*) and a transmission medium (*the network is a transmission medium*).

Dependent claims 2-21 and 24-44 will now be analyzed.

Claims 2 and 24:

Barrot at least teaches storing the base image and the overlay image.

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Claim 3:

Barrot's web browser retrieves the image from the above described database, see claim 23.

Claim 4:

See figure 5a. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barrot so the selected item for inclusion in the viewing room will be composited into the virtual viewing room so the user will be able to view the customized viewing room because the Utah Prime Times article in paragraph 15 describes giving the customers a better way of viewing the items, in paragraph 16 describes giving the user a laser copy of what the headstone will look like and in paragraph 21 describes how this type of personalization helps in the healing process.

Claims 5 and 26:

See paragraphs 0054 and 0063. Applicant claim does not tell where the local computer is located. Paragraph 0054 describes a stand-alone computer and paragraph 0063 describes a local drive. At least paragraph 0054 describes a local computer.

Claim 6:

During inventory updating the web page images may be updated by the server
Web browsers cache server downloaded images and when a new image is required by the web page it is downloaded from the server.

Claim 27:

During inventory updating the web page images may be updated by the server
This claim is broad.

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Claims 7 and 28:

As the use selects funeral items the selections are stored in the database.

Claims 8 and 29:

The web pages of the funeral items include image data, see figure 4d.

Claims 9 and 30:

The family advisor software provides services such as ceremonies and products such as caskets.

Claims 10 and 31:

Prices are displayed in the web page, see paragraph 0081, thus prices were entered into the database.

Claims 11 and 32:

Prices are displayed in the web page, see paragraph 0081, thus prices were retrieved into the database.

Claims 12 and 33:

Themes are discussed with regard to personal expressions feature of the software see paragraph 0084 and figure 5a. Themes links the user to related products.

Claims 13 and 34:

Various themes are listed in paragraph 0084 which at least some correspond to the claimed themes such as hobby and religion.

Claims 14-15 and 35-36:

See paragraph 0084.

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Claims 16 and 43:

See paragraph 0080.

Claims 17 and 44:

See paragraph 0072, 0081, 0082 and 0089 for examples of urn, casket, corners and panels.

Claims 18 and 39:

See claim 9 paragraph 0020.

Claims 19 and 40:

See claims 9 paragraphs 0049 and 0149.

Claims 20 and 41:

This is a broad claim and is met by many aspects of Barrot's family advisor software such as the page shown in figure 4b.

Claims 21 and 42:

See figure 4d which shows at least three areas of the casket which can be customized.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barrot so the image of the selected item for inclusion with the funeral item will be composited onto the image of the funeral item so the user will be able to view the image of the customized funeral item on a display or printout during the funeral planning because the article in paragraph 15 describes giving the customers a better way of viewing the items, in paragraph 16 describes giving the user a laser copy of what the headstone will look like and in paragraph 21 describes how this type of personalization helps in the healing process.

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Claim 25:

See paragraph 0063

Claim 37:

The casket is associated with the base image for the reasons given in claim 23.

Claim 38:

The selected funeral item is associated with the overlay image for the reasons given in claim 23.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barrot et al US Patent Application Publication No. 2003/0212611 is related to the previously cited Barrot publication.

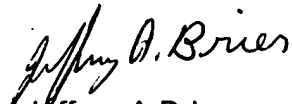
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is 703-305-4723 until the move and after the move the telephone number will be 571-272-7656. The examiner can normally be reached on M-F from 6:30 to 3:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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